



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,061	01/10/2006	Koichi Sakamoto	281994US0PCT	3965
22850	7590	03/26/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHEVIN, MARK L	
			ART UNIT	PAPER NUMBER
			1793	
			NOTIFICATION DATE	DELIVERY MODE
			03/26/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	10/564,061	SAKAMOTO ET AL.
	Examiner	Art Unit
	MARK L. SHEVIN	1793

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 - (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) They raise the issue of new matter (see NOTE below);
 - (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): _____.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 8-21.

Claim(s) withdrawn from consideration: 1-7.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. Other: _____.

/Mark L. Shevin/

/George Wyszomierski/
Primary Examiner
Art Unit 1793

Continuation of 11. does NOT place the application in condition for allowance because: Applicants assert (p. 9, para 1 - 3) that JP '647's inclusion Li₂O content in the range of claims 10 and 13 would not have reasonably lead the skilled artisan to expect a concentration of Li in the steel of between 0.020 and 9 ppm because the inclusions do not have a major diameter of 20 microns or above and are not oxide inclusion particles.

In response, Applicants are improperly focused on the teaching of JP '647 when the rejection of the independent claim 1 explicitly and clearly relies on all of the cited references of JP '068, JP '647, JP '497, and JP '184. JP '647, while not providing the total content of Li₂O in the steel teaches that the Li₂O content in the inclusions should be in the range of dependent claims 10 and 13 at between 0.5 and 10 wt%. As for the size of the inclusions, JP '184 taught that cold drawability, thus raw ductility is maximized by minimizing inclusions to less than 1 inclusion with a diameter of greater than 20 microns per 50 grams sample of matrix material. At issue is not the ability of a skilled artisan to determine the lithium content, but whether one skilled in the art would have expected the lithium content to be in the same range and Applicants have not presented persuasive evidence to the contrary.

Applicants assert (p. 10, last para) that any *prima facie* case of obviousness is rebutted by the significant reduction in density of oxide inclusions particles of 20 microns or above in the claimed range.

In response, JP '647 discloses the concept that adding an alkaline oxide will be advantageous in distributing SiO₂ inclusions as minute particles to JP '184 specifically stated that reducing the density of oxide particles to below 1 of diameter greater than 20 microns per 50 grams of metal would greatly help cold drawability and ductility, thus the particular range of Li present seems inconsequential in view of the teaching of the underlying mechanisms at work in reducing inclusion numbers by JP '497 and JP '184.

Applicants assert (p. 11, fina para) that the cited prior art is silent about the significant reduction in density of oxide inclusion particles by controlling the total-Li content of the steel.

In response, this is not persuasive because the instant claims are drawn to end products, not processes, thus the matter of their making or the end process of controlling the oxide inclusions is not at issue, but rather the reasonable expectation by one skilled in the art of the presence of Li in the claimed range.